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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/025,706	12/26/2001	Joseph David Tanzer	A01199A	6034
21898	7590	04/20/2004	EXAMINER	
ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			NILAND, PATRICK DENNIS	
			ART UNIT	PAPER NUMBER
			1714	

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/025,706	Applicant(s) TANZER ET AL.	
	Examiner Patrick D. Niland	Art Unit 1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8, and 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6,8 and 10-15 is/are allowed.
- 6) ☒ Claim(s) 1-5,16 and 17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat.

No. 5137571 Eisenhart et al..

Eisenhart et al. discloses the instantly claimed compositions of the instant claims 1-5 at the abstract; column 2, lines 24-68; column 3, lines 1-68; column 4, lines 34-68; column 5, lines 1-15; column 6, lines 37-40; column 12, lines 15-68; column 13, lines 30-68; column 14, lines 1-68; column 15, lines 1-22; and the remainder of the document. It is noted that Eisenhart does not refer to these compositions as "tinting compositions". However, the disclosed compositions contain the instantly claimed ingredients and amounts thereof and are necessarily inherently usable as "tinting compositions" because they are able to be mixed with another paint to "tint" it as understood by all of us who have mixed two different paints together to get a desired color, eg. white paint plus red paint to get pink paint.

The applicant has not shown "consisting essentially of" to exclude the binder of the prior art. The applicant has not shown the additional ingredients of the reference to materially affect the basic and novel characteristics of the composition. It is therefore not seen that "consisting essentially of" excludes anything from the composition of the reference. See *In re Janakirama-Rao*, 317 F.2d 951, 137 USPQ 893 (CCPA 1963) and *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). It is further noted that the binder will aid dispersion of the pigment by preventing settling by increasing viscosity. The binder is therefore a "dispersant" and a "thickener" and is expressly encompassed by the overlap of the patentee's binder and the instantly claimed optional components. This rejection is therefore maintained.

4. Claims 1-5 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat.

No. 5137571 Eisenhart et al..

Eisenhart et al. discloses the instantly claimed compositions of the instant claims 1-5 at the abstract; column 2, lines 24-68; column 3, lines 1-68; column 4, lines 34-68; column 5, lines 1-15; column 6, lines 37-40; column 12, lines 15-68; column 13, lines 30-68; column 14, lines 1-68; column 15, lines 1-22; and the remainder of the document. It is noted that Eisenhart does not refer to these compositions as "tinting compositions". However, the disclosed compositions contain the instantly claimed ingredients and amounts thereof and are necessarily inherently usable as "tinting compositions" because they are able to be mixed with another paint to "tint" it as understood by all of us who have mixed two different paints together to get a desired color, eg. white paint plus red paint to get pink paint.

The applicant has not shown "consisting essentially of" to exclude the binder of the prior art. The applicant has not shown the additional ingredients of the reference to materially affect the basic and novel characteristics of the composition. It is therefore not seen that "consisting essentially of" excludes anything from the composition of the reference. See *In re Janakirama-Rao*, 317 F 2d 951, 137 USPQ 893 (CCPA 1963) and *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). It is further noted that the binder will aid dispersion of the pigment by preventing settling by increasing viscosity. The binder is therefore a "dispersant" and a "thickener" and is expressly encompassed by the overlap of the patentee's binder and the instantly claimed optional components. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the colorants of the instant claims 16-17 in the patentee's composition because they encompass the use of all colorants, the colorants of the instant claims are well known commercially available colorants and would have been expected to give their color shade hue etc. to the final composition in proportion to the amount used. This rejection is therefore maintained.

5. Claims 1, 3, and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 3917556 Baurecht et al..

Baurecht et al. discloses the instantly claimed tinting compositions at the abstract; column 1, lines 3-68; column 2, lines 1-40 and the remainder of the document. Its addition to paint falls within the scope of the method of the instant claims 6, 8, and 10. The applicant has not shown "consisting essentially of" to exclude the binder of the prior art. The applicant has not shown the additional ingredients of the reference to

materially affect the basic and novel characteristics of the composition. It is therefore not seen that "consisting essentially of" excludes anything from the composition of the reference. See *In re Janakirama-Rao*, 317 F 2d 951, 137 USPQ 893 (CCPA 1963) and *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). It is further noted that the binder will aid dispersion of the pigment by preventing settling by increasing viscosity. The binder is therefore a "dispersant" and a "thickener" and is expressly encompassed by the overlap of the patentee's binder and the instantly claimed optional components. This rejection is therefore maintained.

6. Claims 1, 3, 5, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 3917556 Baurecht et al..

Baurecht et al. discloses the instantly claimed tinting compositions at the abstract; column 1, lines 3-68; column 2, lines 1-40 and the remainder of the document. Its addition to paint falls within the scope of the method of the instant claims 6, 8, and 10. The applicant has not shown "consisting essentially of" to exclude the binder of the prior art. The applicant has not shown the additional ingredients of the reference to materially affect the basic and novel characteristics of the composition. It is therefore not seen that "consisting essentially of" excludes anything from the composition of the reference. See *In re Janakirama-Rao*, 317 F 2d 951, 137 USPQ 893 (CCPA 1963) and *Ex parte Davis et al.*, 80 USPQ 448 (PTO Bd. App. 1948). It is further noted that the binder will aid dispersion of the pigment by preventing settling by increasing viscosity. The binder is therefore a "dispersant" and a "thickener" and is expressly encompassed by the overlap of the patentee's binder and the instantly claimed optional components.

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It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the colorants of the instant claims 16-17 in the patentee's composition because they encompass the use of all colorants, the colorants of the instant claims are well known commercially available colorants and would have been expected to give their color shade hue etc. to the final composition in proportion to the amount used.

This rejection is therefore maintained.

7. Claims 6, 8, and 10-15 are allowable over the prior art.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Niland whose telephone number is (571) 272-

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1121. The examiner can normally be reached on Monday through Thursday from 10 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

pn

April 18, 2004


Patrick Niland
Primary Examiner
Art Unit 1714